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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
020,383	03/14/79	Jan Heeres	JAB-287

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EXAMINER	
JTovar	
ART UNIT	PAPER NUMBER
12	4

DATE MAILED:

DEC 20 1979

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

GROUP 120

☐ This application has been examined. ☒ Responsive to communication filed on 9-13-79 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited, Form PTO-892. | 2. <input type="checkbox"/> Notice of Informal Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. | 4. <input type="checkbox"/> _____ |

Part II. SUMMARY OF ACTION

1. ☒ Claims 1-16 are pending in the application.
Of the above, claims 2, 3, 6, 7, 12-14 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1, 4, 5, 8, 9, 10, 11, 15-16 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ The formal drawings filed on _____ are acceptable.
8. ☐ The drawing correction request filed on _____ has been ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
☐ been received. ☐ not been received. ☐ been filed in parent application, serial no. _____,
filed on _____.
10. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
11. ☐ Other

Art Unit 122

The claims in the case are 1 to 16.

Claims 2, 3, 6, 7, 12 to 14 stand withdrawn from further consideration as being drawn to non-elected inventions. Election was made without traverse in paper #3.

It is noted that the requirement for election of a single species has not been complied with. (See 37 CFR 1.141). The requirement is repeated.

Claims 1 and 11 are rejected as being an improper Markush claim because it embraces compounds that are unobvious over each other. (In re Ruff et al 1958 C.D. 417)

Claims 1, 4, 5, 8, 9, 10, 11 and 15 to 16 are rejected as being unpatentable under 35 USC 103 over Heeres et al and Heeres. The claimed compounds differ from the prior art compounds in having different substituents on the phenyloxy moiety but the prior art teaches non-criticality of these substituents. (In re Albrecht 198 USPQ 208 (1978) at page 210, col. one 2nd paragraph, 3rd sentence; In re Wood et al 199 USPQ 137; In re Lohr 137 USPQ 548).

Claims 1, 11, 15 and 16 are rejected as being unpatentable under 35 USC 112 1st paragraph, or 35 USC 101. There is no "reasonable assurance" that the scope claimed is operative for the asserted usefulness. The examples and data in

Art Unit 122

Table at pages 36 and 37 are not adequately representative of the scope claimed. (In re Surrey 151 USPQ 724).

Regular drawings are required for the flow diagrams at page 31.

The traverse of improper Markush group and "reasonable assurance" rejection has been very carefully considered but is not persuasive of error in the rejections. The legal basis of an improper Markush rejection is judicial doctrine. (Ex parte Haas 188 USPQ 374). In re Marzocchi et al 169 USPQ 367 is not at all relevant to a "reasonable assurance" rejection. (In re Goffe 191 USPQ 429 at page 431, col. one footnote 1). In the present case "undue experimentation" would be required to use the scope claimed. Has the toxicity of the compounds been determined?



JTovar/maw

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557-3032

12/14/79

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